

REMARKS/ARGUMENTS

Favorable consideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-13 are pending in the present application and Claims 1, 2, 6-8, 12 and 13 are amended by the present response. Claims 14-26 are previously withdrawn. Support for amendments to the claims is found in the disclosure as originally filed. Thus, no new matter is added.

In the outstanding Action, Claims 1-13 were rejected under 35 U.S.C. §101 as directed to non-statutory subject matter; Claims 1-13 were rejected under 35 U.S.C. §112, second paragraph as indefinite; and Claims 1-13 were rejected under 35 U.S.C. §102(b) as anticipated by Ishibashi et al. (EP Pat. App. Pub. No. 1 128 598, herein “Ishibashi”).

With respect to the rejection of Claims 1-13 under 35 U.S.C. §101 as directed to non-statutory subject matter, Applicants respectfully traverse this rejection as improper.

Specifically, with regard to Claims 1 and 2, these claims clearly recite statutory system and apparatus claims. Moreover, Applicants respectfully submit that one skilled in the art would not have interpreted the claims as being “hybrid” claims. Nevertheless, Claims 1 and 2 have been amended to clarify the features which the outstanding Action has determined to be process features in order to further prosecution.

With regard to Claims 6 and 12, Applicants respectfully submit that in light of the recent court decision of *In re Bilski*, Applicants respectfully submit that Claims 6 and 12 are in fact directed to statutory subject matter.

Specifically, in order to determine whether the claimed invention, and particularly Claims 6 and 12, is statutory, the “machine-or-transformation test” should be applied.

The “machine-or-transformation test” states that a process claim is patent-eligible under §101 if (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.

With regard to the first test, Claims 6 and 12 clearly recite that the claimed method is tied to a statutory particular machine or apparatus. For example, both Claims 6 and 12 recite “an information-processing method executed by an information-processing apparatus having a processor and connected to a terminal for using a content through a network.” Clearly the recited method is tied to a statutory particular machine or apparatus.

With regard to Claims 7 and 13, these claims have been amended to recite computer readable storage medium claims.

Accordingly, Applicants respectfully request that the rejection of Claims 1-13 under 35 U.S.C. §101, as directed to non-statutory subject matter, be withdrawn.

With respect to the rejection of Claims 1-13 under 35 U.S.C. §112 second paragraph as indefinite, Applicants respectfully traverse this rejection as improper.

Specifically, with regard to item 16 on pages 4-5 pertaining to Claims 1, 8, 12 and 13, Applicants respectfully traverse the position that one skilled in the art would not have understood the features recited in the claims. Nevertheless, in order to further prosecution, Applicants have amended these claims to clarify the features recited therein.

With regard to item 17 on pages 5-6 pertaining to Claims 1, 2, 6 and 7, Applicants respectfully traverse the position that one skilled in the art would not have understood the features recited in the claims. Nevertheless, in order to further prosecution, Applicants have amended these claims to clarify the features recited therein.

With regard to item 18 on pages 6-7 pertaining to Claims 1 and 2, as is noted above, Applicants respectfully traverse that one skilled in the art would have interpreted the claims

as being “hybrid” claims. Nevertheless, in order to further prosecution, Applicants have amended these claims to clarify the features recited therein.

With regard to item 19 on pages 7-8 pertaining to Claims 1-13, Applicants respectfully traverse the assertion that one of ordinary skill in the art would not be able to reasonably determine the metes and bounds of the phrase “electronic point count.” MPEP §2173.05(a) states

The requirements for clarity and precision must be balanced with the limitations of the language and the science. If the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the statute (35 U.S.C. 112, second paragraph) demands no more.

In the present case, the specification fully and clearly describes the term “electronic point count” such that one of ordinary skill in the art would understand to what this phrase refers. For example, page 53 of the disclosure states “the point count or the electronic point count is used in place of a fee in processing such as a process to purchase a license.” Moreover, in a further example provided on pages 89-90 the disclosure provides that “...in the processing represented by the flowchart shown in Fig. 34, an electronic point count for reproducing the set contents is purchased and points are consumed from the electronic point count each time a set content is reproduced.” One of ordinary skill in the art would clearly understand from this disclosure as well as the plurality of further disclosure on this subject in the specification that the term “electronic point count” refers to an electronic token, such as an electronic piece issued in place of money by some person or body other than a de jure government.

With regard to item 20 on pages 8-9 pertaining to Claims 1-5 and 8-11, Applicants respectfully traverse that the written description fails to disclose the corresponding structure, material or acts for the claimed invention.

The outstanding Action indicates on page 9 in item “q” that “the Examiner has searched the original specification for the terms of the above limitations (e.g. storage means, request means, etc.) and is unable to locate a description of each term that describes the specific structure references by the “means for” language.

However, MPEP 2181 states

The proper test for meeting the definiteness requirement is that the corresponding structure (or material or acts) of a means (or step)-plus-function limitation must be disclosed in the specification itself in a way that one skilled in the art will understand what structure (or material or acts) will perform the recited function. See *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1381, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999)...The disclosure of the structure (or material or acts) may be implicit or inherent in the specification if it would have been clear to those skilled in the art what structure (or material or acts) corresponds to the means (or step)-plus-function claim limitation. See *Id.* at 1380, 53 USPQ2d at 1229; *In re Dossel*, 115 F.3d 942, 946-47, 42 USPQ2d 1881, 1885 (Fed. Cir. 1997).

Thus, the outstanding Action should not have been searching the specification for the exact terms such as “storage means” or “request means” but instead should have been searching the specification to determine what structure (or material or acts) will perform the recited function. For example, “a storage means for storing said contents” is clearly described in Figures 7 & 8 and corresponding disclosure. For instance, on page 39 the disclosure states “the ROM 52 is also used for storing the apparatus ID of the terminal 11 whereas the hard disk 54 is also used for storing the set-content database 12 including set contents.” One skilled in the art would clearly recognize that the hard disk 54 is the structure that will perform the recited function of “storing said contents.” Thus, similarly to the storage means the remaining means elements identified in items ii.-xiv. in item 20(p.) on pages 8-9 are also well supported and described in the originally filed disclosure and thus, Claims 1-5 and 8-11 cannot be reasonably determined as indefinite.

Moreover, Applicants respectfully request that any future Office Action properly examine the disclosure to determine what structure (or material or acts) will perform the recited function. MPEP §2182 states “an examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function.” Applicants note that this burden has not been met in the outstanding Action. Therefore, Applicants respectfully request the Office follow the mandates of MPEP §2182 by appropriately defining and correlating the structure and identical function of the means-plus-function elements (in view of the specification) in any future communication.

Accordingly, Applicants respectfully request that the rejections under 35 U.S.C. §112, second paragraph be withdrawn in light of the above discussion.

Addressing now the rejection of Claims 1-13 under 35 U.S.C. §102(b) as anticipated by Ishibashi, Applicants respectfully traverse this rejection.

Claim 1 recites, in part

said terminal including
storage means for storing said contents in advance;
request means for requesting utilization of
predetermined contents by transmitting content IDs identifying
said predetermined contents among a plurality of said contents
stored in said storage means and by transmitting an electronic
point count for purchasing said predetermined contents, to said
server;

reception means for receiving both a table associating
said content IDs with said electronic point count, and a
utilization condition each transmitted by said server in response
to said request by said request means;

utilization-condition storage means for storing said
utilization condition and said table, which are received by said
reception means; and

utilization execution means for executing utilization of
said predetermined contents on the basis of said utilization
condition and said table, which have been stored in said
utilization-condition storage means;

said server including

utilization-condition transmission means for transmitting said table associating said content IDs with said electronic point count and for transmitting said utilization condition, to said terminal;

sales-history information storage means for storing sales-history information of said predetermined contents pertaining to said range as information including said content IDs identifying said predetermined contents, utilization of which is requested by said request means employed in said terminal;

collection means for collecting sales records of contents utilized by said terminal on the basis of said sales-history information stored in said sales-history information storage means; and

processing execution means for carrying out processing based on said sales records,

wherein said utilization-condition transmission means, employed in said server, is further a means for transmitting a content ID, said electronic point count of which is to be updated, and an update of said electronic point count and said utilization-condition storage means, employed in said terminal, is further a means for updating said table on the basis of said content ID and said update of said electronic point count, which are received from said server.

Claims 2, 6 and 7 recite apparatus, method and medium claims corresponding to the server portion of the claim and Claims 8, 12 and 13 recite apparatus, method and medium claims corresponding to the terminal portion of the claim.

Ishibashi describes an information receiving apparatus that receives identification information and encrypted identification information and makes a comparison between the two in order to prevent illegal utilization of contents data.

However, Ishibashi does not describe or suggest a terminal having utilization execution means for executing utilization of said predetermined contents on the basis of said utilization condition and said table, which have been stored in said utilization-condition storage means, a server having utilization-condition transmission means for transmitting said table associating said content IDs with said electronic point count and for transmitting said utilization condition, to said terminal or that said utilization-condition transmission means,

employed in said server, is further a means for transmitting a content ID, said electronic point count of which is to be updated, and an update of said electronic point count and said utilization-condition storage means, employed in said terminal, is further a means for updating said table on the basis of said content ID and said update of said electronic point count, which are received from said server, as is recited in Claim 1.

The outstanding Action asserts on page 10 in item xviii that control section 360 and paragraph 0735 of Ishibashi describes a terminal having the utilization execution means recited in Claim 1, Applicants respectfully traverse this assertion.

Specifically, Claim 1 recites that the utilization execution means executes utilization of said predetermined contents on the basis of a received utilization condition and a received table which associates the content IDs with the electronic point count. In contrast, the control section 360 of Ishibashi simply executes a purchasing process after the upper controller 351 determines if the submitted money is sufficient to purchase the content requested. Nothing in Ishibashi describes or renders obvious executing utilization of content on the basis of a received utilization condition and a received table which associates the content IDs with the electronic point count.

Furthermore, the outstanding Action asserts on page 10 in item xx that hosting server 331 and paragraph 0728 of Ishibashi describes a server having the utilization-condition transmission means recited in Claim 1, Applicants respectfully traverse this assertion. Specifically, this portion of Ishibashi describes that key information is transmitted from hosting server 331 to kiosk terminal server 357 inside the kiosk terminal 332. Moreover, paragraph 0728 of Ishibashi specifically states that “price information [is] prepared on the KIOSK side.” Thus, Ishibashi does not describe or suggest a server having utilization-condition transmission means for transmitting to said terminal 1) a table associating said content IDs with said electronic point count and 2) a utilization condition of the content.

In addition, the outstanding Action asserts on page 10 in item xxiv that Figure 75 of Ishibashi describes that said utilization-condition transmission means, employed in said server, is further a means for transmitting a content ID, said electronic point count of which is to be updated, and an update of said electronic point count and said utilization-condition storage means, employed in said terminal, is further a means for updating said table on the basis of said content ID and said update of said electronic point count, which are received from said server, as is recited in Claim 1. Applicants respectfully traverse this assertion.

Specifically, Figure 75 of Ishibashi describes a process of modifying previously purchased content utilization rights. For example, as is illustrated in Figure 76, the profit ratio which the re-seller can gain in rule 1 is 30% however it is possible that the profit ratio could be changed to 20% as is the case in rule 4. Nothing in Figure 75 of Ishibashi describes or suggests transmitting a content ID and an update of said electronic point count, the electronic point count corresponding to a price for purchasing said contents. Moreover, nothing in Ishibashi describes or suggests receiving this update at a terminal.

Accordingly, Applicants respectfully submit that Claim 1 and similarly Claims 2, 6, 7, 8, 12 and 13, and claims depending respectively therefrom, patentably distinguish over Ishibashi.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

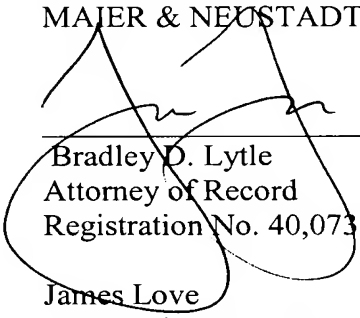
Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAJER & NEUSTADT, P.C.

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)



Bradley D. Lytle
Attorney of Record
Registration No. 40,073

James Love
Registration No. 58,421